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09/801,932	03/09/2001	Larry L. Lu	06975-127001	3453

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EXAMINER
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ARANI, TAGHI T

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/801,932

**Applicant(s)**

LU, LARRY L.

**Examiner**

Taghi T. Arani

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 44-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Claims 44-116 are pending for examination.  
Claims 1-43 are cancelled.  
Claims 44-48, 53-59, 64-65, 67-70 and 75 are amended.  
Claims 78-116 are newly added.

### **Response to Amendment**

2. Applicant's amendment filed 9/8/204 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

### ***Claim Objections***

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Claim 95 has been twice repeated.

For examining the application, the claims 95, 95-115 have been renumbered 95-116.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 78-82, 84-87, 90-94, 95, 97-100, 103-108, 110-113 and 116** are rejected under 35 U.S.C. 102(e) as being anticipated by prior art of record Dieterman (US 6,393,464).

**As per claims 78, 87, 91, 100, 104 and 113**, Dieterman teaches method, system and computer program for monitoring electronic messages that are directed to an intended recipient, the method comprising [abstract, see also col. 3, lines 20-33]:

establishing a supervisory relationship between a supervisory recipient and an intended recipient [col. 3, lines 34-42, account administrator (i.e. a supervisory recipient) establishes and maintains a list of allowed senders and recipients within client email terminal 10 and in database 13 which is accessible to ISP computer 12];

receiving electronic messages (**and emails recited in claims 87, 99 and 112**) transmitted across a delivery network from one or more sender devices and directed to the intended recipient [col. 5, lines 24-45];

delivering a first one of the electronic messages to the supervisory recipient without notifying the intended recipient that the first electronic message has been delivered to the supervisory recipient [col. 4, lines 36-40, see also Fig. 5, col. 6, lines 17-28, Dieterman teaches that when performing the comparison between each named recipient and the contents of the allowed list if it is determined that not all recipients are in fact in the allowed list, then the email message is placed in (i.e. transmitted to) an alternate outbox designated for messages that require administrator approval before being sent and if a message is approved by the administrator, the

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message is moved to the normal outbox for sending upon the next connection to the ISP. If the message is not approved by the administrator, it remains in the outbox for messages needing approval and will be erased after a predetermined amount of time if no approval is granted. That is, the intended recipient of the message is not notified.] ;

enabling the supervisory recipient to review and approve the first electronic message after the first electronic message has been delivered to the supervisory recipient [col. 4, lines 40-51]; and

enabling notification of the first electronic message to be provided to the intended recipient only if the supervisory recipient approves the first electronic message [col. 5, lines 41-45, Dieterman teaches if approval is granted, the email message is placed in the normal inbox (i.e. is the intended recipient is notified).

**As per claims 79-81, 92-94, and 105-107,** Dieterman as modified teach that the sending of messages by a user and viewing of messages received by a user (i.e. an intended recipient) are controlled by an account administrator (i.e. a supervisory recipient) who establishes and maintains a list of allowed senders and recipients of messages [col. 3, lines 34-42, account administrator (i.e. a supervisory recipient) establishes and maintains a list of allowed senders and recipients within client email terminal 10 and in database 13 which is accessible to ISP computer 12 (see also col. 3, lines 34-38). That is, a supervisory recipient for the intended recipient is established and maintained in a database accessible to the ISP. Dieterman further teaches that the user may be a child having an email account established with the ISP and the account administrator is the child's parent or guardian [Dieterman col. 1, lines 65-67]. This suggests the intended recipient and the supervisory recipient have related accounts and screen names. Such

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relationship holds between electronic message address of an employer with an electronic message address of an employee (i.e. associating an electronic message addresses of the supervisory recipient with an electronic message address of the intended recipient).

**As per claims 82, 95 and 108**, Dieterman teaches examining a header of the first electronic message to determine whether the header includes the electronic message address of the intended recipient [Fig. 11, FROM, TO and CC header elements];

determining the electronic address of the supervisory recipient associated with the electronic message address of the intended recipient; and

routing the first electronic message to the electronic message address of the supervisory recipient [col. 5, lines 35-46, i.e. if the identity of the sender of an email is determined to not appear on the allowed list, the incoming message is designated as a message requiring approval, and is placed in the inbox for message requiring approval].

**As per claims 84, 97 and 110**, Dieterman teaches:

examining a header of a second one of the electronic messages to determine an electronic address of the sender of the second electronic message [Fig. 6, element 81, ISP receives incoming messages (plurality of messages)];

comparing the determined electronic address of the second electronic message to at least one sender list [ Fig. 6, element 82] , and

approving or rejecting the electronic message based on a result of the comparison { Fig. 6, element 83}.

**As per claims 85, 98 and 111**, Dieterman teaches that the at least one sender list includes a list of approved senders such that the comparing module compares the determined

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electronic address to the list of approved senders [co. 2, lines 1-19, Dieterman teaches a list of allowed addresses with whom the user is permitted to freely exchange messages].

**As per claims 86 ,99 and 112,** [Dieterman teaches each message sent by or sent to the user will be categorized as either authorized if the other party to the communication appears on the allowed list, or unauthorized (i.e. blocked sender) if the other party does not appear on the allowed list and that outgoing messages that are not authorized will not be transmitted (i.e. will be blocked), see col. 2, lines 1-11].

**As per claims 90, 103 and 116,** Dieterman teaches :

delivering a second one of the electronic messages to the supervisory recipient [ Fig. 6, element 81, ISP receives incoming messages (plurality of messages)] without notifying the intended recipient that the second electronic message has been delivered to the supervisory recipient [see Fig.5, Dieterman teaches that when performing the comparison between each named recipient and the contents of the allowed list it if is determined that not all recipients are in fact in the allowed list, then the email message is placed in (i.e. transmitted to) an alternate outbox designated for messages that require administrator approval before being sent (i.e. the without notifying the intended recipient ) and if a message is approved by the administrator , the message is moved to the normal outbox for sending upon the next connection to the ISP] ; and

automatically forwarding or deleting the second electronic message if the supervisory recipient does not review and approve the second electronic message within a period of time after delivery of the second electronic message to the supervisory recipient [col. 5, lines 44-46, Dieterman teaches If the message is not approved by the administrator , it remains in the outbox

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for messages needing approval and will be erased after a predetermined amount of time if no approval is granted. That is, the intended recipient of the message is not notified].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 88-89, 101-102, 114-115 and 44-77** are rejected under 35 U.S.C. 103(a) as being unpatentable Dieterman as applied to claims 78 and 104 above and further in view of prior art of record, Auvenshine ( U.S. Application No. 2004/0019650).

Dieterman fails to teach wherein the electronic messages are instant messages (chat room messages) such that receiving electronic messages includes receiving instant messages transmitted across a delivery network from one or more sender devices and directed to the intended recipient.

However, Auvenshine is directed to a method, system and program for filtering communications received over a network for a person-to person communication program (i.e. instant message and chat room messages)[ abstract, see also page 2, paragraphs 17 and 26].

Auvenshine's system comprises a plurality of view programs and a filter program. The viewer program comprises application programs that enable users to view or transmit content, such as HTML, web browser newsgroup readers, word processing programs, etc., and communication software that allows person to person communication over the Internet (e.g. chat

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room software, AOL Messenger ,ICQ, etc) .The filter program is capable of filtering content requested by the viewers in order to inhibit access to material deemed undesirable.

Auvenshine's filter program may be included within a gateway computer proxy server [ page 2, paragraph 28].

Auvenshine teaches logic implemented in the filter program to screen packets transmitted over the Internet destined for viewer programs , such as chat room program software, etc.(i.e. intended recipients. The filter program would process the packet and a predetermined list of words or phrases [ page 4, paragraph 39].

Auvenshine further teaches logic implemented in the filter program to allow an administrator to set ratings for packets or documents that are rated acceptable, unacceptable or are rated for further consideration [page 4, paragraphs 40-42].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Dieterman for controlling the delivery of electronic mail messages to incorporate the filter program of Auvenshine to also limit the ability of children to engage in inappropriate communications with adults on IRC chat lines and also help the businesses in limiting not only what employees cannot access, like the child filtering product, but also limiting what they can access [ page 1, paragraphs 6-9].

**Claims 44-77** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dieterman, and further in view of Auvenshine.

**As per claims 44, 56, 67** , Dieterman teaches method , system and computer program for monitoring electronic messages that are directed to an intended recipient, the method comprising:

routing an electronic message directed to an intended recipient to a supervisory recipient [ Dieterman- the sending of email messages by a user and the viewing (i.e. receiving) of email messages received by a user are controlled (i.e. supervised) by an account administrator (i.e. a supervisory recipient) or who establishes and maintains a list of allowed senders and recipients of email messages, see col. 3, lines 34-47];

allowing the supervisory recipient to screen the electronic message and to approve or reject the electronic message [Dieterman- col. 5 , lines 52- 58, i.e. a status flag set or not set indicating whether each message is approved for viewing by the user or not]; and

determining whether to forward the electronic message to the intended recipient based on whether the electronic message is approved by the supervisory recipient [Dieterman (Fig. 5) teaches that when performing the comparison between each named recipient and the contents of the allowed list it if is determined that not all recipients are in fact in the allowed list, then the email message is placed in (i.e. transmitted to) an alternate outbox designated for messages that require administrator approval before being sent and if a message is approved by the administrator , the message is moved to the normal outbox for sending upon the next connection to the ISP. If the message is not approved by the administrator , it remains in the outbox for messages needing approval and will be erased after a predetermined amount of time if no approval is granted. That is, the intended recipient of the message is not notified, see also col. 2, lines 1-40].

Dieterman is silent on controlling (monitoring ) instant messages and chat room messages.

However, Auvenshine is directed to a method, system and program for filtering communications received over a network for a person-to person communication program (i.e. instant message and chat room messages)[ abstract, see also page 2, paragraphs 17 and 26].

Auvenshine's system comprises a plurality of view programs and a filter program. The viewer program comprises application programs that enable users to view or transmit content, such as HTML, web browser newsgroup readers, word processing programs, etc., and communication software that allows person to person communication over the Internet (e.g. chat room software, AOL Messenger, ICQ, etc) .The filter program is capable of filtering content requested by the viewers in order to inhibit access to material deemed undesirable.

Auvenshine's filter program may be included within a gateway computer proxy server [ page 2, paragraph 28].

Auvenshine teaches logic implemented in the filter program to screen packets transmitted over the Internet destined for viewer programs , such as chat room program software, etc.(i.e. intended recipients. The filter program would process the packet and a predetermined list of words or phrases [ page 4, paragraph 39].

Auvenshine further teaches logic implemented in the filter program to allow an administrator to set ratings for packets or documents that are rated acceptable, unacceptable or are rated for further consideration [page 4, paragraphs 40-42].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Dieterman for controlling the delivery of electronic mail

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messages to incorporate the filter program of Auvenshine to also limit the ability of children to engage in inappropriate communications with adults on IRC chat lines and also help the businesses in limiting not only what employees cannot access, like the child filtering product, but also limiting what they can access [ page 1, paragraphs 6-9].

**As per claims 45, 57 and 68**, Dieterman as modified teaches routing the instant message or the chat room message includes notifying the intended recipient that the instant message or the chat room message have been routed to the supervisory recipient [Dieterman discloses that incoming message resides within a single inbox or database list with each message having a status flag set or not set indicating whether each message is approved for viewing by the user or not(i.e. notifying the recipient that the message has been routed to the supervisory recipient, col. 5 , lines 52- 58, see also Fig. 11].

**As per claims 46, 58 and 69**, Dieterman as modified teach routing the instant message or chat room message do not include notifying the intended recipient that the instant message or the chat room message have been routed to the supervisory recipient [Dieterman teaches that when performing the comparison between each named recipient and the contents of the allowed list it if is determined that not all recipients are in fact in the allowed list, then the email message is placed in (i.e. transmitted to) an alternate outbox designated for messages that require administrator approval before being sent and if a message is approved by the administrator , the message is moved to the normal outbox for sending upon the next connection to the ISP, see Fig.5. If the message is not approved by the administrator , it remains in the outbox for messages needing approval and will be erased after a predetermined amount of time if no approval is granted. That is, the intended recipient of the message is not notified].

**As per claim 47,** Dieterman as modified teach enabling the instant message or the chat room message to be screened further comprises:

allowing the supervisory recipient to approve or reject the instant message or the chat room message [Dieterman , col. 5, lines 42-46, i.e. if approval is granted, the email message is placed in the normal inbox (i.e. forwarding the approved message to the intended recipient,. If approval is not given (i.e. rejected), the message will be deleted]; and

forwarding the approved instant message or the chat room message to the intended recipient.

**As per claims 48-49, 59-60 and 70-71,** Dieterman as modified teach enabling the instant message or the chat room message to be screened further comprises:

comparing an electronic address of a sender of the instant message or the chat room message to at least one sender list [Dieterman, col. 3, lines 34-36, col. 4, lines 12-16], and

approving or rejecting the instant message or the chat room message based on a result of the comparison [Dieterman, col. 4, lines 36-52].

wherein at least one sender list includes a list of approved senders such that comparing the electronic address comprises comparing the electronic address of the sender to the list of approved senders recited in claims 49,61 and 72 [co. 2, lines 1-19, Dieterman teaches a list of allowed addresses with whom the user is permitted to freely exchange messages].

**As per claims 50, 61 and 72,** Dieterman as modified the at least one sender list includes a list of blocked senders such that comparing the electronic address comprises comparing the electronic address of the sender to the list of blocked senders [Dieterman teaches each message sent by or sent to the user will be categorized as either authorized if the other party

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to the communication appears on the allowed list, or unauthorized (i.e. blocked sender) if the other party does not appear on the allowed list and that outgoing messages that are not authorized will not be transmitted (i.e. will be blocked), see col. 2, lines 1-11].

As per claim 51-54, 62-65 and 73-76, Dieterman as modified teach establishing the supervisory recipient for the intended recipient [col. 3, lines 34-42, account administrator (i.e. a supervisory recipient) establishes and maintains a list of allowed senders and recipients within client email terminal 10 and in database 13 which is accessible to ISP computer 12 9(see also col. 3, lines 34-38). That is, a supervisory recipient for the intended recipient is established and maintained in a database accessible to the ISP. Dieterman further teaches that the user may be a child having a email account established with the ISP and the account administrator is the child's parent or guardian [ Dieterman col. 1, lines 65-67]. This suggests the intended recipient and the supervisory recipient have related accounts (comprising a single Internet service provider account) with different screen names .

6. **Claims 55, 77, 83, 96 and 109** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dieterman and Auvenshine as applied in claims 1, 78, 91 and 103 above and further in view of prior art of record, Cottrille et al. (U.S. Pat. 6,076,100) .

Combination of Dieterman- Auvenshine fails to disclose wherein the intended recipient and the supervisory recipient have unrelated accounts such that routing the instant message or the chat room message includes routing the instant message or the chat room message to the supervisory recipient account unrelated to the intended recipient account.

Cottrille is directed to a system and method for improved monitoring of chat room conversation , including a database which stores penalty information corresponding to the

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identities of users. When the identity of a user on a channel is received , the database is queried with identity of the user. In response, penalty information corresponding to that user is received, and if found, a penalty corresponding to the penalty information is automatically applied to the user, see abstract.

It would have been obvious to one of ordinary skill in the art to enhance the message controlling system of Dieterman with comprehensive filter program of Auvenshine with the method of Cottrille to provide a chat room monitoring mechanism that allow a single individual (i.e. a supervisory recipient with unrelated account ) to effectively monitor a plurality of chat rooms and deal with improper use of chat rooms , and provide monitors with ability to apply penalties to offending, see col. 1, lines 18-30, see also line 55 through col. 2, line 31.

***Action is Final***

**7. THIS ACTION IS FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

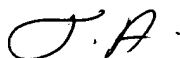
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### Conclusion

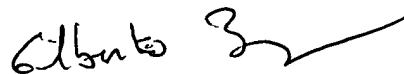
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Taghi T. Arani, Ph.D.  
Examiner  
Art Unit 2131



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